

### Remarks

Applicant has addressed each issue in turn and, for clarity, has provided a heading for each issue.

### *35 U.S.C. § 112*

Claims 1-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Specifically, the Examiner found the claim language “elastomeric members including a quantity of said non-flowable elastomer material” to be indefinite as it was unclear as to how the elastomeric member “includes” the elastomer material.

In the invention, the “elastomeric members” may be made entirely of an elastomeric material, or the “elastomeric members” may include another material in addition to the recited elastomer material. Use of the phrasing “elastomeric members including a quantity of said non-flowable elastomer material” is intended to cover both instances where the elastomeric members are made entirely of elastomeric material, and instances where another material may be present in addition to the elastomer material. The specification does not rule out the possibility that there may be another material present in addition to the elastomer material, and in order to be consistent with the specification, the claims should not rule out that possibility either. In view of this explanation, Applicant believes that the § 112 issue has been adequately addressed.

The Examiner further noted that claim 5 does not start its own paragraph. Applicant inadvertently included claim 5 within the text of claim 4. Applicant has inserted a paragraph break between the end of claim 4 and the beginning of claim 5 to correct this error. In addition, Applicant has amended claims 12, 14 and 19 to correct the improper dependencies.

### ***Double Patenting***

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting in light of claims 1-38 of United States Patent No. 6,026,527. Applicant is filing a terminal disclaimer for this patent application with this Response to Office Action.

### ***35 U.S.C. § 103(a)***

Claims 1-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either United States Patent No. 5,916,664 (“Rudy”) or 6,219,867 (“Yates”). Applicant respectfully submits that the prima facie case for obviousness has not been met as all of the elements of the rejected claims are not found within the combination of Rudy and Yates. Specifically, neither Rudy nor Yates disclose the use of a gel. A gel, as known in the industry, is a liquid suspended within a solid. In an example embodiment, the gel is an A-B-A triblock copolymer that suspends a plasticizing agent (such as an oil) by association of the plasticizing agent with the mid-block of the A-B-A triblock copolymer. Applicant has amended the claims so that they all recite use of a gelatinous elastomer. Rudy and Yates disclose common elastomers, not gels. Nowhere in Rudy or Yates is it suggested to suspend a liquid within a solid. The feel and performance of a gel in a cushion is far superior to that of the common prior art elastomer, and it is therefore superior to anything that Rudy or Yates could provide.

In addition, Applicant submits that there are secondary considerations rebutting a prima facie case of obviousness. Applicant has attached a Declaration of Tony M. Pearce, inventor on this patent application, illustrating commercial success of the invention. The invention as defined by the claims in the Application has been licensed to Schering Plough, Inc. by EdiZONE, LC. Schering Plough was willing to pay \$500,000 in consideration for a grant of the rights covered by the agreements with EdiZONE. Large, well-funded companies with patent

attorneys on retainer, such as Schering Plough, do not generally pay significant sums of money for mere obvious advances in technology. Schering Plough felt that inventor Pearce's invention increased the value of their Dr. Scholl's shoe insole business by at least \$500,000 and was therefore willing to make the payment. In view of the foregoing, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection.

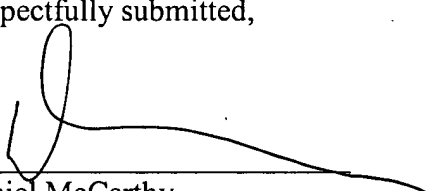
### ***Conclusion***

In view of the foregoing, and in summary, Applicant believes that all issues and points of the Examiner's Office Action have been addressed in a sincere effort to advance prosecution of this Application. Applicant respectfully requests reconsideration and allowance of the pending claims.

Please debit Deposit Account No. 50-0581 for any additional fees.

Dated this 17 day of October, 2003.

Respectfully submitted,



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